

**REMARKS**

Claims 1-24 are pending in the present application. Applicant notes with appreciation that the art-based rejections set forth in the previous Office Action have been withdrawn. However, new grounds of rejection have now been advanced. At least for the reasons stated below, Applicant believes that pending Claims 1-24 are patentable and respectfully requests allowance thereof.

1. Claim Rejection Pursuant to Section 112, Second Paragraph

Claims 1-24 stand rejected under 35 USC §112, second paragraph, based on imprecise usage of the term “e-palette” in the claims, particularly as compared to the information set forth in the specification concerning the term “e-palette” (see, e.g., specification at page 12, lines 4-17). Applicants have amended independent claims 1 and 22, as well as dependent claims 5, 6, 7, 16 and 23 to address and correct such imprecision. Applicant notes that independent claim 15 has not been amended because, as originally presented, the noted imprecision did not appear therein.

As noted in the Office Action, the specification differentiates between an “e-palette” and “parameters associated with an e-palette.” As recited, e.g., in dependent claims 6, 16 and 22, an e-palette may include “color information selected from a group consisting of calorimetric data, spectral data, reflectance data, transmission data, illuminant data, image map, texture map and combinations thereof.” Parameters associated with an e-palette, by contrast, may include “a predetermined set of suppliers, supplier submission condition, supplier response timeframe, cost data, and combinations thereof.” [See, e.g., dependent claims 7, 16 and 22.] Applicant respectfully submits that the specification is

consistent with and fully supports such distinction. As amended, all pending claims also conform to such terminology.

Applicant respectfully submits that no new matter is introduced by way of the noted claim amendments and prompt entry thereof is respectfully requested. Applicant further submits that the pending claims, as amended, obviate the initial issue raised under Section 112, i.e., the imprecise use of the term "e-palette." Reconsideration and withdrawal of such Section 112 rejection is requested.

Turning to the remaining Section 112 issue, applicant has amended dependent claim 20 to provide clear antecedent basis for the recited "information." No new matter has been introduced. Applicant respectfully submits that antecedent basis for the term "entities" is not required. Rather, the "entities" recitation appearing in dependent claim 20 is the initial reference thereto. Reconsideration and withdrawal of the Section 112 rejection of dependent claim 20 is earnestly solicited.

## 2. Claim Rejections Under Sections 102(e) and 103(a)

At pages 3-8 of the Office Action, a series of rejections under Section 102(e) and Section 103(a) are set forth based on newly cited U.S. Patent Publication No. 2002/0169513 to Sherrill et al. (the "Sherrill '513 Publication") and/or U.S. Patent No. 7,034,960 to Stone et al. (the "Stone '960 Patent"). Reconsideration is respectfully requested in view of the Declaration of Richard J. Knapp ("Knapp Declaration") submitted herewith and the remarks which follow.

Simply stated, neither the Sherrill '513 Publication nor the Stone '960 patent is prior art to the present application. As set forth in the Knapp Declaration, the subject

matter disclosed and claimed in the present application, including specifically the subject matter disclosed and claimed in claims 1-24 herein, was conceived and reduced to practice before the earliest possible effective date of the Sherrill '513 Publication (i.e., May 10, 2001) and the Stone '960 Patent (i.e., August 16, 2001). As set forth in 35 USC §102(e) (reproduced in Office Action at page 3), applicant's prior invention of the presently claimed subject matter eliminates the potential prior art effect of the Sherrill '513 Publication and the Stone '916 Patent. Key aspects of the Knapp Declaration are summarized below:

- Mr. Knapp (the sole inventor of the present application) conceived the invention comprising the subject matter of claims 1 to 24 prior to May 10, 2001 (the earliest possible effective date of the Sherrill '513 Publication), and prior to August 16, 2001 (the effective date of the Stone '960 Patent).
- Mr. Knapp exercised due diligence from a date prior to the earliest possible effective date of the Sherrill '513 Publication (i.e., May 10, 2001) and the Stone '960 Patent (i.e., August 16, 2001) to commercialization of the disclosed and claimed subject matter of the application by the assignee, GretagMacbeth, LLC, at least as early as April 23, 2001, and to filing of the application with the U.S. Patent Office on October 23, 2001.
- Mr. Knapp provided a copy of an invention disclosure with his Declaration (Exhibit A) reflecting inventive work that he had engaged in over a period of time up to the date of such invention disclosure. The date appearing on the unredacted version of the invention disclosure precedes the earliest possible effective date of both the Sherrill '513 Publication (i.e., May 10, 2001) and the

Stone '960 Patent (i.e., August 16, 2001). The appended copy of the invention disclosure was obtained from the files of the undersigned attorney and included attorney annotations on the schematics. The annotated schematics were used as informal drawings when the Application was filed with the PTO (original Figures 2 and 3).

- The assignee (GretagMacbeth, LLC) announced the availability of a commercial implementation of Mr. Knapp's claimed invention on April 23, 2001, as demonstrated by the press release attached as Exhibit B, which stated:

Instantaneous exchange of color palettes over the Internet, utilizing NetPalette, enables dye houses to quickly match original design specifications, electronically submit lab dips, receive color approvals via Internet notification and obtain production approval.

\* \* \* \* \*

Using any PC compatible computer, running Windows® 98 or later, color specifiers can easily communicate with their worldwide suppliers. NetPalette allows color specifiers to save an address book of suppliers, a large database of colors, substrates and collections, as well as a history of lab dip submissions, color approvals and comments for each of its supply chain partners.

- As set forth in the press release, a fully functioning NetPalette™ implementation of Mr. Knapp's invention was demonstrated at the ATME-I (American Textile Machinery Exhibition International) exhibition between

April 23 and April 27, 2001, and such demonstration predated the earliest possible effective date of the Sherrill '513 Publication (i.e., May 10, 2001) and the Stone '960 Patent (i.e., August 16, 2001), thereby establishing a reduction to practice prior to the earliest effective dates of the Sherrill '513 Publication and the Stone '960 Patent.

- The NetPalette™ system referenced in the press release and demonstrated at the ATME-I exhibition in April, 2001, generated various screen views as users navigated the functionalities thereof, including specifically the screen shots incorporated into the Application as Figs. 4-17.

For at least the reasons set forth in the Knapp Declaration, applicant respectfully submits that neither the Sherrill '513 Publication nor the Stone '960 Patent is available as prior art under 35 USC §102(e). Reconsideration and withdrawal of all rejections based on the Sherrill '513 Publication and/or the Stone '960 Patent is respectfully requested.

**CONCLUSION**

At least for the reasons stated herein, applicant respectfully requests allowance of pending Claims 1-24. Should there remain any questions or other matters whose resolution could be advanced by a telephone call, the Examiner is invited to contact the undersigned attorney at his number below.

Respectfully submitted,



Basam E. Nabulsi  
Reg. No. 31,645  
Attorney for Applicant

McCARTER & ENGLISH, LLP  
Financial Centre, Suite 304A  
695 East Main Street  
Stamford, CT 06901-2138  
(203) 399-5920  
(203) 399-5820 (fax)